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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/763,507 | 07/25/2001 | Franck Savard | 33354 | 8685 |
| 116 | 7590 | 12/23/2003 | EXAMINER | |
| PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108 | | | CHARLES, MARCUS | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3682 | |

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|----------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/763,507 | SAVARD, FRANCK |
| | Examiner | Art Unit |
| | Marcus Charles | 3682 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5,7-9 and 12-15 is/are rejected.
- 7) Claim(s) 6,10 and 11 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>16</u> | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

This action is responsive to the amendment filed 10-04-2003, which has been entered.

Claims 1-15 are currently pending.

Specification

1. The disclosure is objected to because of the following informalities: in the amendment to paragraph 043 it is unclear as to what is meant by "in the shape of a sharp or pronounced S-curve" that phrase is confusing. Page 7, line 7-9 is confusing because the scope of the phrase; "in which the S is scarcely pronounce and is lying" is unclear and confusing. In addition, it is not clear as to what is meant by the ground clearance is improved.

In page 8, line 4, the phrase "with one 104 of the ends of the spring 106" is confusing because it is unclear if the reference 104 is referring to one end of the spring. If this is so, it is suggested to replace "one 1o4 of the ends" with --one end 104 of the spring--, since only one end 104 was identified in the specification.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second and second paragraphs of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7-9, 13-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does describe as to how the roller comprises a lateral guide means or a pression means and it would not have been obvious to one skill in the art to make a roller such that the roller comprises a lateral guide means or a pression means.

4. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In lines 2-3, the intended scope of the claim is unclear as to the phrase "the same or better ground clearance".

In claim 7-8, it is unclear as to how a guide roller can comprise a lateral guide means or a pression plate. In addition, it is unclear as to what is a pression means.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagano (4,610,644) in view of WO(98/01333). Nagano discloses a rear derailleur for a bicycle comprising a rotatable base (6) having a return spring (13) forcing the base in a in an anti-clockwise direction to balance the free movement of the

base, a guiding means (3) fixedly connected to the base and a moveable tension plate fixedly (2) connected to the guiding means. Nagano does not disclose the base is being forced in the anti-clockwise direction. WO(98/01333) disclosed a rear derailleur comprising a base (128) that is inherently bias by a spring. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the base of Nagano so that it is being bias in the anticlockwise direction in view of WO(98/01333) in order to reduce the chain length, to reduce the distance between the ground level and the derailleur and to reduce the size of the chain derailleur/chain guide.

In claim 2, Nagano discloses the claimed invention and WO(98/01333) shows the chain passing over the first roller (134) and under the second roller (132).

In claim 4, not the pivot axis coincides with the axis of the roller (132).

In claim 12, note the crankcase of WO(98/01333) envelopes derailleur, the gear cluster (114), the pinions and chain (118).

In claim 15, WO(98/01333) discloses the claimed invention above.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagano in view of WO(98/01333) as applied to claim 1 above, and further in view of Juy(3,111,885). Nagano does not disclose the tension is supported pivotally about the center of the tension arm. Juy discloses a tension arm supported pivotally at the center in order to facilitate easy and accurate adjustments of the chainline and to allow free angular displacement of the arm. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the derailleur of

Nagano so that the tension arm is pivotally supported at the center in view of Juy in order to facilitate easy and accurate adjustments of the chainline and to allow free angular displacement of the arm.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagano in view of WO(98/01333) as applied to claim 1 above, and further in view of Nakamura(4,637,808, applicant's prior art). Nagano does not disclose the guide roller in alignment with the tension plate. Nakamura discloses a guide roller (24) in alignment with the tension plate in order to prevent the chain from sagging. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the tension plate of Nagano to include a guide roller in view of Nakamura in order to prevent the chain from sagging.

Allowable Subject Matter

9. Claims 6 and 10-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcus Charles whose telephone number is (703) 305-6877. The examiner can normally be reached on Monday -Thursday 7:30 am-600 pm.


Marcus Charles
Primary Examiner
Art Unit 3682
December 10, 2003